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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,172	03/10/2004	David J. Krause	CS23879RA	4057
20280 7590 03/09/2009 MOTOROLA INC 600 NORTH US HIGHWAY 45 W4 - 39Q LIBERTYVILLE, IL 60048-5343			EXAMINER TORRES, MARCOS L	
			ART UNIT 2617	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/797,172

Applicant(s)

KRAUSE, DAVID J.

Examiner

MARCOS L. TORRES

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9-32 is/are rejected.
- 7) ☒ Claim(s) 6-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 18 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7-22-08 have been fully considered but they are not persuasive.
2. The 112 rejection remains because the applicant was unable to show support from the specification.

Allowable Subject Matter

3. The indicated allowability of claims 1-30 are withdrawn in view of the newly discovered reference(s) to Fette. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 13-18 and 31-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 13 includes the

language "a message stored on a computer readable medium, the channel assignment message" and independent claim 31 includes the language "a channel assignment message stored on a computer readable medium, the channel assignment message". Examiner is unable to locate support in the specification.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 13-18 and 31-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims 13 and 31 are directed to a message which is a mere arrangement of information or data, without any functional interrelationship, tangible output or transformation; and does not fall within a process, machine, manufacture or composition of matter. The rest of the claims have the same deficiencies because their dependencies to claims 13 and 31.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 5, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Fette 6052600.

As to claim 1, Fette discloses a method in a multi-mode wireless communications device (see col. 2, lines 46-60) capable of operating in CDMA and GSM communications modes (see col. 5, lines 5-13; col. 6, lines 3-23), the method comprising: operating the multi-mode wireless communications device in CDMA communications mode (see col. 8, lines 54-59); while operating in CDMA communications mode [in the United States as the example shown], generating an origination message [SMS request message] including information indicating an ability of the multi-mode wireless communications device to operate in GSM communications mode [note that because the request message was sent prior departure was sent in the actual CDMA mode requesting permission to use GSM] (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23).

As to claim 5, Fette discloses a method of transmitting the origination message while operating in CDMA communications mode [note that because the request message was sent prior departure was sent in the actual CDMA mode requesting permission to use GSM] (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23).

As to claim 10, Fette discloses a method in a multi-mode wireless communications device capable of operating in first and second communications modes in corresponding first and second networks (see col. 5, lines 5-13; col. 6, lines 3-23), the method comprising: operating the multi-mode wireless communications device in the

first mode communications mode on the first network (see col. 8, lines 54-59); while operating in the first communications mode, generating a message including information indicating an ability of the multi-mode wireless communications device to operate in a second communications mode on the second network, the message is one of an origination message [note that because the request message was sent prior departure was sent in the actual CDMA mode requesting permission to use GSM] (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23).

As to claim 12, Fette discloses a method indicating an ability of the multi-mode wireless communications device to operate in a third communications mode [analog, TDMA, etc.] on one of the first and second network [note that because the request message was sent prior departure was sent in the actual CDMA mode requesting permission to use GSM] (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23).

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 19, 21 are 23-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Karabinis US 20050079816A1.

As to claim 19, Karabinis discloses a method in a CDMA communications network (see par. 0044, 0164), the method comprising: generating a channel assignment message; providing GSM channel assignment information in the channel assignment message (see par. 0081, 0226, 0259, 0260).

As to claim 21, Karabinis discloses a method of providing GSM channel assignment information in the channel assignment message includes providing assignment information for one of a GSM access grant channel (see par. 0259).

As to claims 23 and 26, Karabinis discloses a method of transmitting the channel assignment message to a wireless communications device connected to the CDMA communications network, providing the GSM channel assignment information in the channel assignment message includes providing a direct channel assignment (see par. 0081, 0226, 0259, 0260).

As to claims 24 and 27, Karabinis discloses a method of transmitting the channel assignment message to a wireless communications device connected to the CDMA communications network, providing the GSM channel assignment information in the channel assignment message includes providing an access grant channel for the communications device to complete set up on the GSM network (see par. 0081, 0226, 0259, 0260).

As to claim 25, Karabinis discloses a method for network resource allocation in a first communications network, the method comprising: receiving a message from a multimode mobile station; generating a channel assignment message for the multimode mobile station operating in a first communications on the first network in response to the

message; assigning the multimode mobile station to a second network in the channel assignment message; transmitting the channel assignment message to the multimode mobile station (see par. 0081, 0226, 0259, 0260).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 2-4, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fette in view of Uchida US007072359B2.

As to claims 2 and 9, Fette discloses generating a message [SMS] indicating that the multi-mode wireless communications device is able to operate in GSM communications mode (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23). Fette does not disclose the message includes setting a first field indicating that the message includes a second field. However, in an analogous art

Uchida discloses that SMS message includes setting a first field [message type, message identifier, num fields, etc] indicating that the message includes a second field (see fig. 2a, 2b; see col. 5, line 11 – col. 6, line 36). Uchida discloses the details of the anatomy of a SMS message, although Fette does not disclose the details of the SMS is using the same type of message, thereby having the same anatomy. Therefore, it would be obvious to one of the ordinary skills in the art at the time of the invention that SMS message have first field indicating details of the composition of the message for the simple purpose of correctly receiving the message according the information on the field.

As to claim 3, Fette discloses generating a message [SMS] indicating that the multi-mode wireless communications device is able to operate in GSM communications mode (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23). Fette does not disclose the message includes setting a second field. However, in an analogous art Uchida discloses the origination message includes setting the second field to indicate that the multi-mode wireless communications device is able to operate in GSM communications mode (see fig. 2a, 2b; see col. 5, line 11 – col. 6, line 36). Uchida discloses the details of the anatomy of a SMS message, although Fette does not disclose the details of the SMS is using the same type of message, thereby having the same anatomy. Therefore, it would be obvious to one of the ordinary skills in the art at the time of the invention that SMS message have first field indicating details of the composition of the message for the simple purpose of correctly receiving the message according the information on the field.

As to claim 4, Fette discloses the method of indicating whether the multi-mode wireless communications device is capable of communicating in at least one of a GSM mode (see col. 5, lines 5-13; col. 6, lines 3-23). Fette does not specifically disclose which GSM mode if is GSM single-slot mode or a GSM multi-slot mode. However, since the claim recites the two possible outcomes, inherently it have to be one of the two possibilities.

As to claim 11, Fette discloses generating a message [SMS] indicating that the multi-mode wireless communications device is able to operate in GSM communications mode (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23). Fette does not disclose setting a flag. However, in an analogous art Uchida discloses the origination message includes setting a flag indicating the presence of more information (see fig. 2a, 2b; see col. 5, line 11 – col. 6, line 36). Uchida discloses the details of the anatomy of a SMS message, although Fette does not disclose the details of the SMS is using the same type of message, thereby having the same anatomy. Therefore, it would be obvious to one of the ordinary skills in the art at the time of the invention that SMS message have first field indicating details of the composition of the message for the simple purpose of correctly receiving the message according the information on the flag.

15. Claim 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karabinis in view of Muniere US 20040047343A1.

As to claim 20, Karabinis discloses a method of providing GSM channel assignment information in the channel assignment message (see par. 0259). Karabinis

does not disclose providing information indicating that additional GSM channel assignment information is provided in the channel assignment message. In an analogous art, Muniere discloses providing information indicating that additional GSM channel assignment information is provided in the channel assignment message (see par. 0029, 0037, 0038). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to provide additional information for the simple purpose of providing more than one resource.

As to claim 22, Karabinis discloses a method of providing GSM channel assignment information in the channel assignment message includes providing information (see par. 0259). Karabinis does not specifically disclose including information to re-send one of an origination message or page response message on a GSM Channel. In an analogous art, Muniere discloses including information to re-send one of an origination message or page response message on a GSM Channel (see par. 0038). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to include information to re-send one of an origination message to request a more precise description of the required resources. Additionally re-send data is a common and well-known technique used when the information was incorrectly received or was not received.

16. Claims 13-18 and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karabinis in view of Fette.

As to claim 13, Karabinis discloses a message for origination or page response by a multimode communications device, the message comprising: a first additional

mode information field of the message for indicating an ability of a multimode communications device to accept a channel assignment and a second additional mode information field of the message for indicating an ability of the multimode communications device to accept a channel assignment in a second additional mode other than the first mode (see par. 0029, 0037, 0038). Karabinis does not specifically disclose a first additional mode. In an analogous art, Fette in a first additional mode other than a first mode or second mode [analog] (see col. 6, lines 3-24). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to include additional modes for the simple purpose of compatibility.

As to claims 14-15 and 17, both references disclose the message of, the first mode is a CDMA communications mode, the first additional mode information field for indicating an ability of the multimode communications device to accept a channel assignment in one of the CDMA communications mode and the analog communications mode and the second additional mode is a GSM communications mode, the second additional mode information field for indicating an ability of the multimode communications device to accept a channel assignment in the GSM communications mode (see par. 0029, 0037, 0038 for Karabinis and col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23 for Fette). And Fette also disclose that the first additional mode is an analog communications mode, which is not disclosed by Karabinis(see col. 6, lines 3-24). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to include additional modes for the simple purpose of compatibility.

As to claims 16 and 18, Karabinis discloses the message of the first additional information field for indicating a preference of the multimode communications device to accept a channel assignment in one of the first mode (see par. 0029, 0037, 0038). Karabinis does not specifically disclose the first additional mode. In an analogous art, Fette discloses the first additional mode, the second additional information field for indicating an ability of the multimode communications device to accept a GSM channel assignment in the second additional mode (col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23). Therefore, it would have been obvious to one of the ordinary skills in the art at the time of the invention to include additional modes for the simple purpose of compatibility.

As to claims 28-30, Karabinis discloses a method in a multimode communications device, the method comprising: receiving a channel assignment message while operating in a first mode pursuant to a first communications protocol, the channel assignment message; transitioning to one of an access grant channel or a dedicated channel based on the channel assignment information for the different mode of operation (see par. 0081, 0226, 0259, 0260). Karabinis does not specifically disclose including channel assignment information for a mode of operation pursuant to a second communications protocol. In an analogous art Fette discloses including channel assignment information for a mode of operation pursuant to a second communications protocol (see col. 8, lines 54-64; col. 7, lines 42-49; col. 8, lines 15-20; col. 6, lines 3-23). Therefore, it would be obvious to one of the ordinary skills in the art at the time of the invention to combine the reference to provide compatibility with multiple modes.

Regarding claims 31 and 32, they are rejected for the same reasons as claims 28 and 30.

Allowable Subject Matter

17. Claims 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. The following is a statement of reasons for the indication of allowable subject matter: The method of receiving a channel assignment message, in response to sending the origination message, while operating in CDMA communications mode, the channel assignment message including GSM assignment information, have not been found or fairly suggested in the prior art search.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS L. TORRES whose telephone number is (571)272-7926. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marcos L Torres/
Examiner, Art Unit 2617